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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BERCH, MARK L

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 07/30/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,692

Applicant(s)

MULLER ET AL.

Examiner

Mark L. Berch

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 20-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13 and 16-19 is/are rejected.
- 7) ☒ Claim(s) 12, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s): ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-19, drawn to processes.

Group II, claim(s) 20-28, drawn to compounds.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The reasons are as set forth in the PCT/IPEA/409. The problems to be solved by the invention are different, and thus there is no single inventive concept. Different references were shown to be closest to the different groups. Group I involves the special technical feature of soluble metal complexes, not present in Group II which involves esters.

During a telephone conversation with Robert McCarthy on 7/12/02 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-19.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 20-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 5, 6-7, 13, 16-19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 3, line 2 and 7 should be "dihydro forms" (two words). Likewise in claim 5.
2. In claim 6, the term "heterohydrocarbon" is self-contradictory in claim 6. A hydrocarbon by its nature has no heteroatom.
3. The variable definitions in claim 6 are unclear. The definition begins by saying that R1 or R2 is H, but then says that they both could be the assorted radicals. But if both are those radicals, then neither R1 nor R2 is H. The definition must be clarified.
4. "Preferably" is improper alternative language (In re Kingston, 65 USPQ 371).
5. The term "respective" in claim 15 is unclear. If applicants are trying to say that the two are attached to the same ring, or are attached to different rings, some other wording needs to be used.
6. The "12" at page 57, line 25 isn't written correctly.
7. Claim 16 is improperly dependent on claim 15. The last page 58 choice is not provided for in claim 15, which does not permit substituted ferrocene. In addition, the second page 59 choice is also not provided for. In addition, the claim 15 choice a) option says that the chain has only 4-6 carbons so that the rings on page 58 line 2, 14 etc. are not permitted. Moreover, as a hydrocarbon group, the oxygen atoms seen in the alkoxy of page 58 line 8 and oxygen atoms elsewhere, N of lines 11 and 13 and halogen of line 15, etc. are not permitted.

8. The term "acyl" is indefinite (page 58, line 13). Does this embrace acids of S? P? As? What does the stem look like, i.e. if the acyl is e.g. RC(O), what is R? In carboxylic acid acyls, does the carbon count include the carbon of the carbonyl?
9. What does "skeleton" in last line of claim 17 refer to?
10. Claim 12's "the alcoholic reaction medium" lacks antecedent basis in claim 1.
11. In claim 19, what is a "complex" acid as opposed to a non-complex one?
12. The choices of X8 and X9 as allyl or methyl-allyl do not made sense. Such a compound would have a net +2 charge. Should there two additional anions bound to the metal? Two counterions? Use of Ru(0)? For whichever choice is made, applicants must show that one of ordinary skill in the art would have known that this choice, and not another, was intended.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-11, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Boyle.

The reference refers to the use of soluble Rh catalysts to give asymmetric results. Note the sentence bearing the footnotes 2 and 3, and the work in this paper using hydrogen with a Rh-pyridine complex with an asymmetric amine. With regard to claim 6, this would appear to be partially in the salt form.

Claims 12, 14, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Information Disclosure Statement

The references cited in the Search Report of the PCT application have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within the set period for reply to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.



Mark L. Berch
Primary Examiner
Art Unit 1624

July 24, 2002